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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,399	04/03/2001	Kevin X. Chen	IN01154K	1622

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PATENT DEPARTMENT (K-6-1, 1990)
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EXAMINER	
MONDESI, ROBERT B	

ART UNIT	PAPER NUMBER
1653	

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/825,399	CHEN ET AL.	
	Examiner	Art Unit	
	Robert B Mondesi	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *18 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25,27 and 31-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *31-35* is/are allowed.

6)☒ Claim(s) *1-25,27 and 36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to amendment filed May 12, 2003. **Claims 1-17** as drawn to elected Invention I are currently pending and are under examination

Withdrawal of Objections and Rejections

The rejection of **claim 31 and 32** under 35 U.S.C § 112, second paragraph is withdrawn.

The rejection of **claims 1-2** under 35 U.S.C § 102(b) as being anticipated by Brunk et al. is withdrawn.

The objection of claims 3-25, 27, and 33-36 as being dependent on rejected claims is removed.

New Rejections

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-25, 27 and 36 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for macrocyclic compounds in table 1 (1-11) and in the specification example 1-110 (pages 62-355), does not reasonably provide enablement for all the compounds presented by the general structure formula (I) of claim 1. The specification does not enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to use or make the invention commensurate in scope with these claims.

The factors to be considered in determining whether undue experimentation is required are summarized In re Wands 858 F.2d 731, 8 USPQ2nd 1400 (Fed. Cir.1988). The court in Wands states: "Enablement is not precluded by the necessity for some experimentation such as routine screening. However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue,' not 'experimentation.' " (Wands, 8 USPQ2d 1404). Clearly, enablement of a claimed invention cannot be predicated on the basis of quantity of experimentation required to make or use the invention. "Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations." (Wands, 8 USPQ2d 1404). The factors to be considered in determining whether undue experimentation is required include: (1) the quantity of experimentation necessary, (2) the amount or direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. Although the quantity of experimentation alone is not dispositive in a determination of whether the required experimentation is undue, this factor does play a central role. For example, a very limited quantity of experimentation may be undue in a fledgling art that is unpredictable where no guidance or working examples are provided in the specification and prior art, whereas the same amount of experimentation may not be undue when viewed in light of

some guidance or a working example or the experimentation required is in a predictable established art. Conversely, a large quantity of experimentation would require a correspondingly greater quantum of guidance, predictability and skill in the art to overcome classification as undue experimentation. In Wands, the determination that undue experimentation was not required to make the claimed invention was based primarily on the nature of the art, and the probability that the required experimentation would result in successfully obtaining the claimed invention. (Wands, 8 USPQ2d 1406). Thus, a combination of factors which, when viewed together, would provide an artisan of ordinary skill in the art with an expectation of successfully obtaining the claimed invention with additional experimentation would preclude the classification of that experimentation as undue. A combination of Wands factors, which provide a very low likelihood of successfully obtaining the claimed invention with additional experimentation, however, would render the additional experimentation undue.

1.Breadth of the claims.

In regards to the method of the invention and the breadth of the claims the broadest interpretation that applies is to compounds presented by the general structure formula (I) of claim 1. Neither of the independent claims or their subsequent dependent claims, when given their broadest interpretation in light of the specification, are enabled for all the possible compounds presented by the general structure formula (I) of claim 1. In other words the scope of the claims only encompasses the macrocyclic compounds mentioned in table 1 and in the specification from example 1-110 (page 62-355) that have been shown to exhibit HCV serine protease inhibitory activity.

2. The nature of the invention.

The invention is a novel class of pharmaceutical compounds that are inhibitors of Hepatitis C Virus (HCV) protease activity, specifically macrocyclic compounds that inhibit HCV NS3/NS4a serine protease activity.

3. The state of prior art.

In regards to the macrocyclic compounds of the invention presented by the general structure formula (I) of claim 1, the prior art does not provide any evidence of HCV protease inhibitory activity- specifically with regards to HCV NS3/NS4a serine protease inhibitory activity.

4. The relative skill in the art.

The relative skill in the art as it relates to pharmaceutical macrocyclic compounds that inhibit the activity of HCV serine protease is that of a M.D. or Ph. D. level individual.

5. The level of predictability in the art.

Since the prior art does not teach that the compounds presented by general formula (I) of claim 1 formerly existed, the level of predictability is low in regards to the macroclycic compounds of the invention with respect to HCV serine protease inhibitory activity. Therefore, one of skill in the art would not be able to readily anticipate the inhibitory effects of the macrocyclic compounds of the invention in view of HCV NS3/NS4a serine protease inhibitory activity.

6. The amount of guidance present.

The applicant has not provided guidance for all the compounds presented in the general formula (I) of claim 1. In table 1 of the specification of the present application ,

the applicant has provided results of a HCV protease continuous assay for a group of macrocyclic compounds wherein the applicant has categorized the Ki values associated with each investigated compound as a barometer of HCV serine protease inhibitory activity. If the Ki of a given compound is between 1-100nM then the compound is in category b, any value for a given compound that is above 100nM is considered to be in category a. The applicant has shown some guidance as to how certain macrocylic compounds of the invention (table 1) can be used to perhaps inhibit HCV protease activity - but the applicant has not provided guidance for all the compounds presented in the general structure formula (I) of claim 1 in regards to how they can be used to inhibit HCV serine protease activity.

7. The existence of working examples.

The specification, on pages 62-335, provides specific working examples of macrocyclic compounds (table 1) that can be used to inhibit HCV serine protease activity. However, the specification does not provide working examples of all compounds suggested by the general structure formula (I) of claim 1.

8. The quantity of experimentation necessary.

In the case of using all the compounds suggested by the general structure formula (I) of claim 1, a large quantity of experimentation needs to be disclosed since there is evidence that only certain compounds (macrocyclic compounds in table 1) suggested by the general formula of claim 1 will inhibit HCV serine protease activity.

Due to the quantity of experimentation still required to be performed by one skill in the art in regards to how to use all the compounds suggested by the general formula

(I) of claim 1, the lack of guidance presented in the specification regarding the same, the absence of a working example directed to same, the unpredictable nature of the invention with regards to HCV serine protease inhibitory activity, the state of the prior art not providing any evidence that all the compounds suggested by general formula (I) of claim 1 will exhibit HCV serine protease inhibitory activity , and the breath of the claims which fails to provide particular steps for all compounds suggested by the general formula (I) of claim 1 exhibiting HCV serine protease inhibitory activity, the specification fails to teach the skilled artisan in the art how to make and use the invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 09/908,955. Although the conflicting claims are not identical, they are not patentably distinct from each other because when in general formula (I) of

claim 1 of present application W and Q are missing (page 366) and in the general formula (I) of claim 1 of application 09/908,955 W and M are missing, the two claims and their subsequent dependent claims are identical in scope.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/013,071. The general structure formula (I) of claim 1 of application 10/013,071 falls with the scope of the general structure formula (I) of present application

This is a provisional obviousness-type double patenting rejection.

Conclusion

Claims 1-25, 27 and 36 are not allowed.

Claims 31-35 are allowed

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B Mondesi whose telephone number is 571-272-0956. The examiner can normally be reached on 9am-5pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RM

Robert B. Mondesi
Patent Examiner
Group 1653
03-20-04

ROBERT A. WAX
PRIMARY EXAMINER